



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,422	11/25/2003	David William Treppess	282531US8X	2677
22850 7590 06/25/2007 OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER COLAN, GIOVANNA B	
			ART UNIT 2162	PAPER NUMBER
			NOTIFICATION DATE 06/25/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/723,422

Applicant(s)

TREPESS ET AL.

Examiner

Giovanna Colan

Art Unit

2162

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 June 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims. 6c.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-14 and 16-39.
Claim(s) withdrawn from consideration: 15.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.


JOHN BREENE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

Continuation of 11. does NOT place the application in condition for allowance because: 1. Applicant states that claim 1, and 21 have been amended to incorporate limitations of claim 15. However, the amended (incorporated limitation) "wherein the information items are at least associated with image items" was recited in preamble of old claim 15. Such recitation was not given patentable weight because the recitation occurred in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Additionally, such recitation "wherein the information items..." as currently amended, also includes "associated with image items comprising image data;" which require further search by the examiner. Therefore, for all these reasons, the amended limitation "wherein the information items are at least associated with image items comprising image data"(currently recited in claims 1, 21, and 34) requires further search by the examiner.

2. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

3. Applicant argues that since " as admitted in the outstanding Office Action, the '237 patent fails to disclose a self-organizing map"; then "the '237 patent must also fail to disclose a detector for detecting positions within a self-organizing map, and a graphical user interface for displaying display points representing positions within the self-organizing map, as required by Claim 1".

Examiner respectfully disagrees. As stated in the Final Office Action dated December 15, 2006 (page 4), Claim 1 has been rejected under 103 combination or references. Specifically, the combination of Jain ('237 according in applicant's arguments) in view of Kohonen does disclose: a detector for detecting those positions within a self organizing map corresponding to the selected information items (Col. 1,5 and 20, lines 34 - 37 and 6 - 8; respectively, the [ROW, COLUMN] position, Jain; and Page 1, b. Scope of This Work, para. 1, Kohonen), and a graphical user interface for displaying display points representing those positions within the self-organizing map (Col. 11, and 12, lines 62 - 64 and 1 -3, respectively, Jain ; and Page 1, b. Scope of This Work, para. 1, Kohonen). Specifically, as discussed above, Jain discloses a detector for detecting those positions corresponding to the selected information items (Col. 1,5 and 20, lines 34 - 37 and 6 - 8; respectively, the [ROW, COLUMN] position, Jain), and Kohonen discloses not only self-organizing map but also detecting positions in a 2-D grid in a self-organizing map (Page 1, 3rd paragraph under section "I. INTRODUCTION", Kohonen). (Also see - Final Office Action dated December 15, 2006).

4. Applicant argues that the prior art fails to disclose; "the processor provides one or more image items representative of the information content of the selected information items defined by the search criteria".

Examiner respectfully disagrees. The combination of Jain in view of Kohonen and further in view of Weiss discloses the recited limitation: the processor provides one or more image items representative of the information content of the selected information items defined by the search criterion (Col. 9, lines 25 - 34, "which given a term (or image query), executes a victionary search and returns a set of equivalent features...it searches for the visual senses of each recognized concept...the method identifies the visual senses by finding the nominal features, Jain; and Page 5, [0111], lines 1 - 5, "the names of the clusters that contain instance(s) of the searched words are presented to the user...", Weiss)

5. In response to applicant's argument that; "one of ordinary skill in the art would have not been motivated to combine the teachings of the '237 patent and Kohonen et a. reference because such combination would lead to nonsensical system. In such a combined system, the selected, separate, and direct comparisons for different features of an image... would have to be performed at the same time as the comparison of all the features simultaneously...would have no expectation of success in combining...", the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

6. In response to applicant's argument that there is no suggestion to combine the Jain reference with the Weiss reference, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Weiss reference provides a motivation to combine the references (See - Final Office Action dated 12/15/2006, Page 13).